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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,848	05/11/2001	Kenneth Arneson	20-487	5684

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EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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2153

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/852,848

Applicant(s)

ARNESON ET AL.

Examiner

Yasin M. Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/19/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 26, 2007 has been entered.

Response to Amendment

2. The amendment filed on October 26, 2007 has been fully considered but are not persuasive.

- Claims 1-6 9-25 have been cancelled.
- Claims 7, 26-33 are amended.
- Claims 7-8 and 26-33 are presented for examination.

Response to Arguments

Regarding claims 2, 28-30, 32 and 33, the Applicant argues "Chack fails to disclose automatically retrieving pre-designated

desired information without a need to answering a call from a first device, much less disclose using call related information to automatically retrieve pre-designated desired information in response to a call from a first device without answering the call from the first device; and transmitting the retrieved pre-designated desired information to the first device, as recited by claims 26, 28-30, 32 and 33." (page 6, last paragraph).

Examiner respectfully disagrees. Chack teaches "The transaction processing system provides a URL to the telephone caller. The web page associated with the URL contains information requested by the caller" col. 7, lines 61-65; col. 8, lines 61-63 and col. 9, lines 46-48). Information requested by the user during the call includes desired information and thus a pre-designated information in response to a call is retrieved without a need to answering said call from said first device (col. 7, lines 61-65 and col. 8, lines 61-63). (Providing web page information to the telephone caller identified by the processing without answering the phone meets the argued limitation). In this way therefore no connection charges are incurred since no connection was established.

Regarding claims 7 and 8, applicant argues "The Examiner acknowledged the Pepe fails to teach "transmitting information

to a device without answering a call." (See Office Action, page 7). However, the Examiner is ignoring the specifically recited type of information that is provided to a communications device without answering a call. Claims 7 and 8 specifically recite providing an email to a communications device without answering a call. For Pepe to make up for the deficiencies in Chack, Pepe would have to disclose not just any type of information, but specifically an email." (Page 6, last paragraph). Examiner respectfully disagrees. It seems the applicant is arguing against the references individually. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Pepe teaches providing a communication device (PDA 30) an email message. Chack is relied upon without answering a call providing desired information. Therefore, the combined references teach the argued limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 26, 28-30 and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Chack USPN. (6751211).

As per claim 26, and 30 Chack teaches a method of retrieving information by a first device (Fig. 3, 60) from a second device (fig. 3, 68), comprising:

Receiving a call from a first device associated with a first telephone number at second device associated with a second telephone number (a telephone caller initiates a call to a telephone number associated with a transaction processing system col. 7, lines 61-63. See also col. 9, lines 43-46 and the abstract;

using call related information to automatically retrieve pre-designated desired information in response to said call from said first device without a need to answering said call from said first device (the transaction processing system provides a URL to the telephone caller without answering the call col. 7, lines 61-65 and col. 8, lines 61-63); and

transmitting retrieved pre-designated desired information to said first device ("The transaction processing system provides a URL to the telephone caller. The web page associated with the URL contains information requested by the caller" col. 7, lines 61-65; col. 8, lines 61-63 and col. 9, lines 46-48).

As per claims 28 and 32 Chack teaches a method of retrieving information by a first device from a second device, further comprising:

determining said second telephone number from call related information associated with said call to said first telephone number by said first device [col.6, 11-18 and col. 8, lines 24-32].

As per claim 29 and 33, Chack teaches a method of retrieving information by a first device from a second device, wherein:

said caller related information is caller ID [col.6, 11-18 and col. 8, lines 24-32].

Claims 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Makela USPN. (6301338).

As per claims 7 and 8, Makela teaches the method of providing electronic mail notification to a communications device (abstract), comprising:

associating an email with a first phone number and using call related information from said call to automatically identify (col. 5, lines 2-11) and provide said email to said

communications device after said communications device calls a first phone number [col. 5, lines 31-36 and col. 8, lines 30-36].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chack USPN. (6751211) in view of Pepe et al USPN (5742668).

Regarding claims 27 and 31, although Chack shows substantial features of the claimed invention including transmitting retrieved pre-designated information to a telephone number as explained in claims 26 and 30 above, he does not explicitly show transmitting means in a short message.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chack, as evidenced by Pepe (5742668).

In analogous art, Pepe et al whose invention is about a network which provides a variety of electronic text delivery, receipt, and notification options system, disclose a means of transmitting short message to SMS capable devices (col. 5, lines 22-30 and col. 21, lines 40-52]. Giving the teaching of Pepe et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chack by employing the system of Pepe et al in order to limit the messages sent to the wireless messaging equipment of mobile employee and to receive only urgent messages when a mobile employee away from his office.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al USPN (5742668) in view of Chack USPN. (6751211).

As per claim 7, Pepe et al teach the method of providing electronic mail notification to a communications device, comprising:

associating an email with a first phone number (the number called by the subscriber) receiving a call from a communications device (subscriber portable device 32) [col. 21, 15-67]; and using call related information from said call to automatically identify (col. 6, lines 47-65 and col. 21, lines 18-67] and provide said email to said communications device after said communications device calls a first phone number [col. 7, lines 30-46 and col. 21, lines 18-67].

Although Pepe et al shows substantial features of the claimed invention including providing emails to a communication device, he does not explicitly show transmitting desired information to a device without answering a call.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pepe et al, as evidenced Chack USPN. (6751211).

In analogous art, Chack whose invention is about a method for communicating information, discloses a transaction processing system that provides a desired information (a URL) to a telephone caller without answering the call (col. 7, lines 61-65 and col. 8, lines 61-63). Giving the teaching of Chack, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Pepe et al by

employing the method providing information to a telephone caller without answering the call of Chack. One ordinary skill in the art would do so because the transaction processing system does not answer the incoming call therefore no connection charges are incurred since no connection was established.

As per claim 8, Pepe et al teach the method of providing electronic mail notification to a communications device according to claim 7, further comprising:

obtaining a communications device identifier when said communications device dials said first phone number, and using said communications device identifier to select said electronic mail message [col. 14, lines 46-63 and col. 21, 40-65].

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

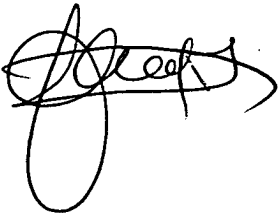
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Y. Barqadle

Art Unit 2153

A handwritten signature in black ink, appearing to read 'Y. Barqadle', with a large, stylized loop at the bottom.